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“It was also observed that human TIF work on murine cells and vice versa.”

The example showed the induction of STAT 3 and STAT 5. When the example is taken as a whole – as it must – the conclusion is that the type of TIF/IL-21 is irrelevant. The example states expressly that what matters is the cell source.

With respect to Dumoutier, et al., relied upon by the examiner, applicants advise that the Federal Circuit has expressly prohibited the use of past filing date prior art in rejections under 35 USC § 112. Attached are copies of In re Koller, 204 USPQ 702 (1980) and In re Hogan, 194 USPQ 521 (CCPA 1977), with relevant passages marked.

In addition to this, if a paper is going to be cited, and employed, then everything it teaches must be considered.

The examiner points to a statement made at page 10144 of the Dumoutier paper, i.e., that “IL-TIF” failed to activate signal transducer and activator of transcription –3 (STAT-3), in mouse macrophages. The paper is NOT as categorical as the examiner says it is. Further, if one reads 10 lines further down from the quote, the reference states:

“A similar effect has been observed on Mes 13, a kidney mesangial cell line, but not on a series of lymphoid and macrophage cell lines, suggesting that IL-TIF acts mainly outside the immune system.”

Correctly stated, the issue is what type of cell has been used, not what kind of TIF, nor what STAT molecule. Applicants’ claims are written such that this feature is embraced. The cell contacted must be one “capable of said expression,” i.e., expression of a STAT transcription factor. The examiner’s position cannot be maintained.

As to the second rejection, the examiner argues that there is insufficient enablement for any acute phase protein in any cell using any IL-21/TIF. Applicants traverse.

First, the burden is on the examiner to show each item allegedly non-enabled. Applicants call upon the examiner to provide a single example of an acute phase protein not induced by IL-TIF/IL-21 - any IL-TIF/IL-21 – in any cell. Applicants are entitled to request this evidence, and now do so. The examiner has also not drawn any correlation between the alleged lack of enablement for STAT expression and acute phase proteins.

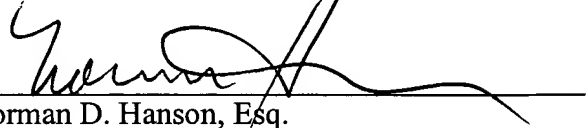
The examiner is reminded that an application is presumed to be enabled, and it is the examiner’s burden to show, via a preponderance of the evidence, not by mere speculation, that

claims are not enabled. The office action sets forth speculation without evidence. This is insufficient, and the rejection should be withdrawn.

Allowance of this application is believed proper and is urged.

Respectfully submitted,

FULBRIGHT & JAWORSKI, L.L.P.

A handwritten signature in black ink, appearing to read 'Norman D. Hanson', is written over a horizontal line.

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As to whether Dr. Kelleher "did not properly check for contamination" after receipt of the *Candida* he had ordered and while he was subculturing and maintaining them, we find that the three pages of Dr. Kelleher's testimony relied on by the board do not support its conclusion. The fact that a particular culture depository (e.g., CBS) provided for streaking<sup>7</sup> in conjunction with reviving its freeze-dried cultures (but not in conjunction with their subsequent maintenance and transfer) does not indicate that streaking is the only acceptable method to detect contamination in such a culture as it is received from a depository, and it has earlier been shown that the depositories are regarded as reliable. We note that the directions for reviving the freeze-dried cultures from another collection (ATCC) do not mention streaking. Thus, Dr. Kelleher's statement that he did not streak cultures from the CBS depository does not establish that he employed an unacceptable technique for detecting contamination. The remainder of Dr. Kelleher's testimony, which the board regarded as an "admission" of possible contamination, is reproduced below:

Q843. We are dealing with yeast, or alleged yeasts in these experiments. Allegedly we have 16 separate types of yeast, or at least strains.

Isn't there the possibility of cross-contamination as between these various cultures?

A. A possibility, but much lower than a possibility of contamination by an airborne contaminant.

Q844. There is the possibility of both in the handling, transferring and propagation that led up to the beginning of these inter partes tests?

A. Yes.

It is quite clear that Dr. Kelleher was testifying only as to the hypothetical possibility of contamination and was not testifying that such contamination had occurred. To the contrary, he testified:

<sup>7</sup> "Streaking" is the preparation of a "streak culture," a culture which is inoculated with an "inoculum implanted (as with a needle drawn across the surface) in a line or stripe upon a solidified culture medium." Webster's Third New International Dictionary (1971). As Dr. Kelleher testified, this method gives rise to separate colonies on the culture medium, and may be used to detect contamination if "the contaminating organism has a sufficiently different appearance when growing on [the] medium."

Q271. Do you have any reason to believe that in the course of the transferring, that contamination of these cultures had been introduced?

A. No.

For the above reasons, we hold that the board erred in according "little, if any" weight to the experimental work of Dr. Kelleher and that the board did not give proper weight to other pertinent evidence. We hold that the disclosure of the first Tabuchi Japanese application would not compel those of ordinary skill in the art to perform undue experimentation in selecting a suitable strain of *Candida* to practice the method of the count. That application thus meets the enablement requirement of the first paragraph of 35 USC 112, and Tabuchi, therefore, is entitled to the benefit of the filing date of that application under 35 USC 119. Since this date is earlier than the date of Nubel's actual reduction to practice, the basis on which Nubel was awarded priority, the decision of the board is reversed.

### Court of Customs and Patent Appeals

In re Hogan and Banks

No. 76-641 Decided July 28, 1977

#### PATENTS

##### 1. Applications for patent — Continuing (§15.3)

35 U.S.C. 120 requires copendency.

##### 2. Applications for patent — Continuing (§15.3)

##### Specification — Sufficiency of disclosure (§62.7)

Principle that applicant cannot rely on what occurred in art after filing date because application sufficiency under 35 U.S.C. 112, first paragraph, must be judged as of its filing date, applies equally to Patent and Trademark Office with respect to continuing application entitled under Section 120 to benefit of earlier filing date; no rational distinction can be made in treatment accorded to subject matter of original

application and to same subject matter disclosed in continuing application; courts should not treat same legal question, enablement under Section 112, in one manner with respect to applicant and in different manner with respect to examiner.

### 3. Applications for patent — Continuing (§15.3)

**Patentability — Anticipation — Carrying date back of references (§51.203)**

**Pleading and practice in Patent Office — Rejections (§54.7)**

**Specification — Sufficiency of disclosure (§62.7)**

Examiner and Board of Appeals must show why scope of enablement is insufficient to support claims; to permit use of references that would not have been available in support of 35 U.S.C. 102 or 103 rejection entered in connection with ancestral application in support of Section 112 rejection would render "benefit" of Section 120 illusory; limit upon continuing applications is matter of policy for Congress, not court; law as set forth in Sections 112 and 120 is same for all applications, whether of long or short pendency; purpose of reliance on Section 120 is to reach back, to avoid effect of intervening references; nothing in Section 120 limits its application to any specific grounds for rejection, or permits examiner, denied use of references to reject or to require narrowing of claim under Section 102 or 103, to achieve same result by use of same references under Section 112; just as justice and reason require application of Section 112 in same manner to applicants and examiners, symmetry in law, and evenness of its application, require that Section 120 be held applicable to all bases for rejection, that its words "same effect" be given their full meaning and intent.

### 4. Applications for patent — Continuing (§15.3)

**Specification — Sufficiency of disclosure (§62.7)**

Application for invention disclosed in manner provided by first paragraph of 35 U.S.C. 112 in application previously filed in United States should have been tested for Section 112, first paragraph compliance as though filed on date of prior application.

### 5. Applications for patent — Continuing (§15.3)

It is immaterial under Section 120 that subject matter of claim was not specifically claimed in ancestral applications.

### 6. Patentability — Evidence of — State of art (§51.467)

**Specification — Sufficiency of disclosure (§62.7)**

Later state of art is that state coming into existence after filing date of application; Court of Customs and Patent Appeals' approval of use of later publications as evidence of state of art existing on filing date of application where later publication evidenced that as of application's filing date, undue experimentation would have been required, or that parameter absent from claims was or was not critical, or that statement in specification was inaccurate, or that invention was inoperative or lacked utility, or that claim was indefinite, or that characteristics of prior art products were known, does not extend to use of later publication disclosing later existing state of art in testing earlier application for compliance with Section 112, first paragraph; difference may be described as that between permissible application of later knowledge about art-related facts existing on filing date and impermissible application of later knowledge about later art-related facts, which did not exist on filing date; thus, if applicants' ancestral application provided sufficient enablement, considering all available evidence, whenever it became available, of state of art at that time, i. e., of condition of knowledge about all art-related facts existing at time, fact of enablement was established for all time and later change in state of art cannot change it.

### 7. Claims — Broad or narrow — In general (§20.201)

**Patent grant — Intent of patent laws (§50.15)**

Pioneer invention deserves broad claims to broad concept; "basic inventions" have led to "basic patents," which amounted to real incentives, not only to invention and its disclosure, but to its prompt, early disclosure.

### 8. Claims — Broad or narrow — In general (§20.201)

**Patent grant — Intent of patent laws (§50.15)****Specification — Sufficiency of disclosure (§62.7)**

Insisting that applicants should have disclosed in ancestral application, form that did not exist until nine years later, would be to impose impossible burden on inventors and thus on patent system; there cannot, in effective patent system, be such burden placed on right to broad claims; to restrict applicants to form disclosed would be poor way to stimulate invention, and particularly to encourage its early disclosure; to demand such restriction is merely to state policy against broad protection for pioneer inventions, which is both shortsighted and unsound from standpoint of promoting progress in useful arts, which is purpose of patent laws.

**9. Specification — Sufficiency of disclosure (§62.7)**

There is higher level of predictability in mechanical or electrical environments compared to lower level of predictability expected in chemical reactions and physiological activity; there is no distinction, however, between fields of invention with respect to erroneous use of later state of art in determining enablement.

**10. Patentability — Aggregation or combination — Improving old element (§51.155)****Specification — Sufficiency of disclosure (§62.7)**

Patents are and should be granted to later inventors upon unobvious improvements; indeed, encouragement of improvements on prior inventions is major contribution of patent system and vast majority of patents are issued on improvements.

**11. Construction of specification and claims — By specification and drawings — In general (§22.251)****Pleading and practice in Patent Office — In general (§54.1)****Specification — Sufficiency of disclosure (§62.7)**

Business of Patent and Trademark Office is patentability, not infringement; like judicially-developed doctrine of equivalents, designed to protect patentee with respect to later-developed variations of claimed invention, judicially-developed "reverse doctrine

of equivalents," requiring interpretation of claims in light of specification, may be safely relied upon to preclude improper enforcement against later developers; major and infinitely important function of Patent and Trademark Office is to insure that those skilled in art are enabled, as of filing date, to practice invention claimed; if, in light of all proper evidence, invention claimed is clearly enabled as of that date, inquiry under 35 U.S.C. 112, first paragraph, is at end.

**12. Construction of specification and claims — In general (§22.01)****Specification — Sufficiency of disclosure (§62.7)**

Specification disclosure as whole must be considered.

**13. Amendments to patent application — New matter (§13.5)****Claims — Specification must support (§20.85)****Specification — Sufficiency of disclosure (§62.7)**

New matter rejection under 35 U.S.C. 132, predicated on claim language, is tantamount to rejection for lack of written description of claimed invention under Section 112, first paragraph.

**14. Applications for patent — Continuing (§15.3)**

There has to be continuous chain of copending applications each of which satisfies requirements of 35 U.S.C. 112 with respect to subject matter presently claimed; there must be continuing disclosure through chain of applications, without hiatus, to ultimately secure benefit of earliest filing date.

**Particular patents — Solid Polymers**

Hogan and Banks, Solid Polymers of Olefins, rejection of claims 13 and 14 reversed; rejection of claim 15 affirmed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of John Paul Hogan and Robert L. Banks, Serial No. 181,185, filed Sept. 16, 1971, continuation of application, Serial No. 648,364, filed June 23, 1967, division of application, Serial No. 558,530, filed Jan. 11, 1956, continuation-in-part of application, Serial No. 476,306, filed Dec. 20, 1954 and application, Serial No. 333,576, filed Jan. 27, 1953. From deci-

sion rejecting claims 13-15, applicants appeal. Modified; Miller, Judge, concurring in part, with opinion.

E. Eugene Innis, and Young & Quigg, both of Bartlesville, Okla., for appellants.

Joseph F. Nakamura (Fred E. McKelvey, of counsel) for Commissioner of Patents and Trademarks.

Before Markey, Chief Judge, and Rich, Baldwin, Lane, and Miller, Associate Judges.

Markey, Chief Judge.

This appeal is from the decision of the Patent and Trademark Office (PTO) Board of Appeals affirming various rejections, under 35 USC 102, 103, 112 (first paragraph), and 132, of claims 13-15 in appellants' application No. 181,185 filed September 16, 1971 (the 1971 application) for "Solid Polymers of Olefins."<sup>1</sup> A main issue involves use of a "later state of the art" as evidence to support a rejection.

The 1971 application is said to be a continuation of application No. 648,364 filed June 23, 1967 (the 1967 application), in turn a "divisional" of application No. 558,530 filed January 11, 1956 (the 1956 application)<sup>2</sup>. The 1956 application is a continuation-in-part of application No. 476,306 filed December 20, 1954 and application No. 333,576 filed January 27, 1953 (the 1953 application).

We affirm in part, reverse in part, and remand with respect to certain rejections.

### The Claims

Although the 1971 application discloses several polymers, the claims are limited:<sup>3</sup>

13. A normally solid homopolymer of 4-methyl-1-pentene.<sup>4</sup>

14. A polymer of claim 13 having a melting point in the range of 390 to 425°F.

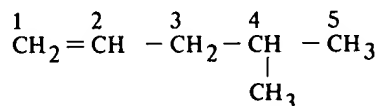
15. A polymer of claim 13 which is wax-like and thermally stable as evidenced by substantially no decomposition at temperatures below about 700°F. as shown by Figure 5.<sup>5</sup>

### The Disclosures

Appellants assert that, under the provisions of 35 USC 120,<sup>6</sup> claims 13 and 15 are entitled to the benefit of the filing date of the 1953 application and claim 14 is entitled to the benefit of the filing date of the 1956 application.

The 1953 application discloses solid polymers made from 1-olefin monomers having a maximum chain length of eight carbon atoms and no branching nearer the double bond than the 4-position. Several olefin monomers which form such polymers are disclosed: ethylene, propylene, 1-butene, 1-pentene, 1-hexene, and 4-methyl-1-pentene.

A method of making such polymers using a catalyst containing chromium oxide on a silica-alumina support is described. The application includes twenty "examples" and twenty-five "tables" giving detailed information on: how to prepare, activate, use, and regenerate the catalyst; how to influence the molecular weight of the polymer products; what solvents or diluents to use in admixture with the olefin feed; what feed velocities, reaction pressures, reaction temperatures, and reaction times are operative; and certain physical and



<sup>5</sup> "Figure 5" of the 1971 application is described *infra*.

<sup>6</sup> §120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor *shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.* [Emphasis added.]

<sup>1</sup> The real party in interest is Phillips Petroleum Company.

<sup>2</sup> The 1956 application is still pending. See note 3, *infra*.

<sup>3</sup> At oral hearing, appellants' counsel stated that the 1956 application is involved in the "famous" polypropylene interference (see, e.g., *Standard Oil Co. v. Montedison, S.p.A.*, 540 F.2d 611, 191 USPQ 657 (CA3 1976)) and "when that case got into the district court, we gave up on our hope for a generic product claim and filed applications to each one of the several species [of polymers]."

<sup>4</sup> 4-Methyl-1-pentene has a structural formula with carbon atoms numbered as follows:

chemical characteristics of the polymer products.

Example I in the 1953 application includes this statement, which we designate as [A]:

[A]

4-Methyl-1-pentene gave tough, solid polymer which, however, was successfully expelled from the reactor in continuous-flow operation.

Example XVI refers to Figure 2 in the drawings, which is a graph showing thermal depolymerization curves for five polyolefin polymers and commercial polyisobutylene. Example XVI includes this statement, which we designate as [B]:

[B]

Whereas the former [commercial polyisobutylene] began to decompose at about 600°F, the latter (polymers of propylene, 1-butene, 1-pentene, 1-hexene, and 4-methyl-1-pentene) began to decompose at about 700-725°F.

Example XIX describes polymerizing 4-methyl-1-pentene "over chromia-alumina-silica catalyst" and states: "The 4-methyl-1-pentene polymer is a tough solid polymer suitable for a substitute for natural waxes."

The 1956 application is a continuation-in-part application and as filed contains

most, but not all, of the information found in the 1953 application. Missing from the 1956 application as filed are statement [B] and the graph of Figure 2. Included in the 1956 application are the following new statements not present in the 1953 application, which we designate as [C] and [D]:

[C]

We have produced crystalline polymers of 4-methyl-1-pentene which have melting points in the range of 390 to 425°F.

[D]

1-Butene and 4-methyl-1-pentene can be polymerized in substantially the same manner as previously described and produce crystalline polymers. One sample of 4-methyl-1-pentene polymer thus obtained had a melting point of 394° to 421°F. A second similar polymer of 4-methyl-1-pentene produced in the same general manner had a melting point of 410 to 420°F.

The 1967 application, according to appellants' brief before the board, contains all of the disclosures relating to polymers of 4-methyl-1-pentene contained in the 1953 and 1956 applications. The 1971 application on appeal contains statements [A] and [B], the Figure 2 graph (now Figure 5), and statements [C] and [D].

The following table summarizes the disclosures:

Application (filing date)	Statement [A]	Statement [B]	Fig. 2 (now Fig. 5)	Statement [C]	Statement [D]
1-27-53	yes	yes	yes	no	no
1-11-56	yes	no	no	yes	yes
6-23-67	yes	yes	yes	yes	yes
9-16-71	yes	yes	yes	yes	yes

### References

The references relied upon by the examiner and board were:

- Haven 3,257,367 June 21, 1966 (filed June 23, 1955)  
 Edwards 3,299,022 January 17, 1967 (filed April 4, 1962)  
 Edwards 3,317,500 May 2, 1967 (filed October 2, 1963)  
 Natta et al., *Rendiconti dell'Accademia Nazionale dei Lincei*, Series VIII, Vol. XIX, No. 6 (December 1955), pp. 397-403.

Haven discloses a solid poly-4-methyl-1-pentene which is described as crystalline and, when oriented as a fiber, shows a melting point of 235°C (455°F)



Edwards ('022) describes a solid, amorphous, elastomeric homopolymer of 4-methyl-1-pentene. The patent states that a 1,4-type linkage<sup>7</sup> is almost exclusive, being over 95% of the repeating linkages in the homopolymer of 4-methyl-1-pentene, when polymerization using an aluminum chloride catalyst is conducted at temperatures below -60°C. The patent further states that "[i]t has been thought possible heretofore to obtain polymerization of olefins only through [1,2-type linkage]" and that a "structural copolymer" is obtained which contains structural units of the 1,2-type linkage as well as of the 1,4-type linkage, when polymerization is conducted at a higher temperature.

Edwards ('500) discloses a 1,4-type polymer of 4-methyl-1-pentene in a cross-linked form having a molecular weight in excess of 1,000,000.

Natta et al. (Natta) discloses a poly-4-methyl-1-pentene which is crystalline and which has a melting point of 205°C. (401°F.) as determined by X-ray examination.

### Rejections

The following rejections were affirmed by the board:

(1) Claims 13-15 under 35 USC 112, first paragraph,<sup>8</sup> as "based on a non-enabling disclosure."

(2) Claim 14 under 35 USC 112, first paragraph, as "based on a disclosure which does not teach how to prepare polymers having the claimed melting point range" of 390 to 425°F.

(3) Claim 14 under 35 USC 132 as "containing new matter in the combination of 'homopolymer' and the melting point range of 390° to 425°F."

(4) Claims 13-15 under 35 USC 102 as "fully met by Natta et al." (Natta).

(5) Claims 13 and 15 under 35 USC 102 as "fully met by Haven."

<sup>7</sup> A reference to the number 1 carbon of one molecule of 4-methyl-1-pentene (note 4, supra) linking to the number 4 carbon of another molecule of 4-methyl-1-pentene.

<sup>8</sup> §112. Specification.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same \* \* \* [Emphasis added]

(6) Claim 14 under 35 USC 103 as "unpatentable over Haven."

### The Examiner's Answer

(1) With respect to the rejection of claims 13-15 under 35 USC 112, first paragraph, as based on a non-enabling disclosure, the examiner stated:

This rejection is premised on the fact that while the claims are generic in nature, applicants have, at best, only described a very limited species within the generic class. It is believed that the scope of the enablement provided by this specification is not commensurate with the scope of the protection sought. In re Moore, [58 CCPA 1042, 439 F.2d 1232,] 169 USPQ 236 [(1971)].

\* \* \* The disclosure \* \* \* is non-enabling on how to prepare other species of this polymer such as those of Natta et al, Haven, Edwards ('022) and Edwards ('500) which, as far as this record is concerned, could not be prepared with the supported chromium oxide catalyst.

\* \* \* The point is \* \* \* that the claims are much broader than the polymers actually prepared in that about the only thing they have in common is that all are normally solid.

(2) With respect to the rejection of claim 14 under 35 USC 112, first paragraph, as based on a disclosure which does not teach how to prepare polymers having the claimed melting point range of 390 to 425°F., the examiner stated that "[c]laim 14 reads on a single 'species' of polymer which begins to melt at 390°F and is completely melted at 425°F or on any species that melt within this range." The examiner stated further that this rejection followed from a prior board decision (not of record) involving the 1967 application which held that the disclosure was non-enabling on how to make "a species" which had a melting point "of 410 to 420°F" (found in statement [D]). The examiner reasoned that the specification must also be non-enabling for "the only other 'species' which discloses a melting point, i.e., '394 to 421°F'" (found in statement [D]), and, therefore, "[i]f the only disclosure of polymers having certain melting points is non-enabling, the raw disclosure of polymers having even broader melting points could not possibly be enabling," referring apparently to statement [C].

(3) With respect to the rejection of claim 14 under 35 USC 132 as containing new matter in the combination of

"homopolymer" with the melting point range of 390° to 425°F., the examiner explained that the only support for the temperature range appears in statement [C] and that the support for "homopolymers" presumably is derived from statement [D], but that the combination of these two limitations was created by amendment and, therefore, constituted new matter.

(4) With respect to the rejection of claims 13-15 under 35 USC 102 as fully met by Natta, the examiner stated that appellants "agree" that the 4-methyl-1-pentene polymer of Natta "anticipates these claims" and that the "only issue" is whether Natta is "prior art to these claims."

Regarding claim 13, the examiner said that Natta is "a statutory bar" because nowhere in the 1971, 1967, or 1956 applications was there "an enabling disclosure" under 35 USC 112, first paragraph, for the reasons cited above with respect to rejection (1). The examiner did not mention the 1953 application.

On claim 14, the examiner said that Natta "is prior art" for the reasons given for claim 13, for the additional reasons cited above with respect to rejections (2) and (3), and further because appellants' affidavit under 37 CFR 1.131 (Rule 131) "does not establish reduction to practice of this claim prior to December, 1955," which is Natta's publication date.

Regarding claim 15, the examiner said that Natta "is prior art" for the reasons given for claim 13 and that Natta is "a statutory bar" because the claimed subject matter is not disclosed in the 1956 application (i.e., statement [B] and the graph (now Figure 5) are not in that application).

(5) With respect to the rejection of claims 13 and 15 under 35 USC 102 as fully met by Haven, the examiner stated that "[t]he Haven poly(4-methyl-1-pentene) would inherently possess the thermal stability properties of claim 15 in view of its high melting point" and that Haven is "a statutory bar to these claims" for the reasons given for Natta, above.

(6) With respect to the rejection of claim 14 under 35 USC 103 as unpatentable over Haven, the examiner stated that the oriented fiber of Haven having a melting point of 235°C. (455°F.) would be expected to have a higher melting point than the un-

oriented polymer of appellants and, therefore, the range of 390 to 425°F. recited in claim 14 would have been obvious. The examiner said Haven is "prior art" on this claim for the reasons given for Natta, above. The examiner also said that appellants' Rule 131 affidavit does not antedate Haven because the affidavit "does not establish reduction to practice or even conception of the generic range 390-425°F."

#### The Board

The board affirmed the rejections "for reasons essentially as given by the Examiner" which the board adopted as its own. The board then proceeded to add certain "comments for emphasis."

The board said that statement [C] "stands alone as a statement apparently unconnected with the preceding or following disclosure," and that "[i]t gives no clue as to how a polymer of 4-methyl-1-pentene having the recited range of melting points is to be prepared \* \* \*." The board concluded that "[t]he disclosure is clearly non-enabling with respect to a teaching requisite to inform the artisan of how to make the claimed polymer."

The board further stated that the disclosure "is restricted to a teaching of how to make crystalline polymers," but that the claims are "not limited to a crystalline polymer of 4-methyl-1-pentene" but "encompasses an amorphous polymer as well, which is manifestly outside the scope of the enabling teaching present in the case."

The sole references to appellants' earlier applications, and to their Rule 131 affidavit, were contained in this paragraph:

Inasmuch as we sustain the Examiner's rejections under 35 U.S.C. 112 and 132, appellants are palpably not entitled to the benefit of the filing dates of their parent cases which have essentially the same relevant disclosure as present herein; the Natta et al. article and Haven patent are thus statutory bars and an affidavit under Rule 131 becomes inappropriate. Consequently, we affirm the rejections of the appealed claims under 35 U.S.C. 102 as fully met by Natta et al. or Haven and do not reach nor decide the adequacy of the Rule 131 affidavit.

#### Appellants' Contentions

Appellants contend that the board committed "serious error" in affirming the rejection of claims 13-15 under 35 USC 112, first paragraph, as based on a non-enabling dis-

\* The Condensed Chemical Dictionary 448 (8th ed. 1971) defines "homopolymer" as "[a] polymer derived from a single monomer \* \* \*."

closure. Appellants argue that the board failed to recognize the "pioneer" status<sup>10</sup> of appellants' invention and that the adequacy of their application should be judged by the state of the art as of its filing date. Relying upon 35 USC 120, appellants assert the benefit of their January 27, 1953 filing date for claims 13 and 15 and their January 11, 1956 filing date for claim 14.

Appellants argue that the board erred in affirming the rejection of claim 14 under 35 USC 112, first paragraph, because their disclosure leaves "no doubt" as to how to make the polymers recited in claim 14. Appellants refer to statement [C], statement [D], and to examples which give specific conditions suitable for making polymers of 4-methyl-1-pentene, and argue that §112 does not require a specification to contain a specific working example in order to be enabling.

With respect to the rejection of claim 14 under 35 USC 132 as containing new matter, appellants state that the board affirmed this rejection for the reasons given by the examiner, to wit, that the specification as originally filed does not support the combination of "homopolymer" with the recited melting point range because statement [C] includes copolymers and limiting that melting point range to homopolymers is "new matter." Appellants argue that the examiner and the board have considered statement [C] completely out of context with the rest of the specification.

Finally, appellants contend that claims 13 and 15 are entitled to the benefit of the filing date of the 1953 application which is prior to Natta and Haven, that claim 14 is entitled to the filing date of the 1956 application, which is less than one year subsequent to Natta and to the effective date of Haven, and that appellants' affidavit under Rule 131 shows prior completion of the invention of claim 14. Thus, appellants contend that claims 13 and 15 are free of the rejections under 35 USC 102 by virtue of the 1953 filing date and that claim 14 is free of rejections under 35 USC 102 and 103 because the Rule 131 affidavit removes Natta and Haven. Because the board declined to consider the adequacy

of appellants' Rule 131 affidavit, appellants request that the case be remanded to the board for consideration of the affidavit if this court reverses the rejections under 35 USC 112 and 132.

#### The Solicitor

The solicitor supports the examiner and the board and further argues that appellants' claims cover a genus of homopolymers of 4-methyl-1-pentene, including both low and high molecular weight homopolymers; that "at best" appellants teach how to make only low molecular weight homopolymers; that it is possible in view of Natta, Haven, Edwards ('022), and Edwards ('500) to produce homopolymers having high molecular weights; and, therefore, "the enabling disclosure in the specification is not commensurate in scope with the breadth of the claims." The solicitor points out that appellants' Rule 131 affidavit shows that they possessed certain molecular weight data (showing a molecular weight of 1,800 for a polymer of 4-methyl-1-pentene) prior to the filing date of their 1956 application, yet such data were not included in that application. Furthermore, the solicitor points to Edwards ('500) which discloses homopolymers of 4-methyl-1-pentene having molecular weights greater than 1,000,000. Thus, the solicitor contends that the examiner and the board made out a prima facie case that appellants' enabling disclosure is not commensurate in scope with the claims.

In response to appellants' argument that their disclosure should be judged by the state of the art as of its effective filing date, the solicitor states:

The references relied upon by the examiner to demonstrate the shortcomings of appellants' disclosure all have dates prior to the filing date of this [1971] application. Hence, until appellants establish that their present specification is sufficient, there is no need to determine what disclosure might have been sufficient in 1953 and 1954 when appellants' grandparent applications were filed. [Bracketed matter added.]

On the rejection of claim 14 as containing new matter, the solicitor argues that appellants do not disclose, in their 1971 application as filed, any homopolymers having melting points at the "outer limits" of the range 390 to 425°F. and that "the only melting points disclosed are for homopolymers in the range of 394 to 421°F. and 410 to 420°F."

<sup>10</sup> Their brief states: "The present specification describes a truly pioneer invention which is the first normally solid polymer of 4-methyl-1-pentene ever made." (Appellants' emphasis.) Whether appellants' invention is of "pioneer" status is not before us and bears no relation to our decision herein, though such status may influence the decision required on remand, as appears *infra*.

With respect to the prior art rejections, the solicitor states:

Consideration by the Court of the prior art rejections becomes necessary only if the lack of enablement rejection and new matter rejection are reversed. Since the Board had held that appellants' grandparent disclosures are essentially the same as the present disclosure with respect to claim 13 and 15, should the lack of enablement rejection and new matter rejection be reversed, the prior art rejections of claims 13 and 15 should also be reversed and the appeal should be remanded with respect to claim 14, because the Board did not rule on the sufficiency of the affidavit submitted by appellants under 37 CFR §1.131 \* \* \*.

#### *I. Disregard of the Effect of 35 USC 120*

The board premised the rejection of claims 13-15 under 35 USC 112, first paragraph, on insufficient enablement in appellants' 1971 application, disregarding entirely the statutory right of appellants under 35 USC 120. That was clear error.

That the board looked only to appellants' 1971 application is clear from its statement quoted above. Because it sustained the rejections under 35 USC 112 and 132, the board said, "appellants are palpably not entitled to the benefit of the filing dates of their parent cases which have essentially the same relevant disclosure as present herein." The board did not specifically mention 35 USC 120 and its action deprived appellants of their rights under that portion of the statute.

In apparent recognition of the nature of the board's action, the solicitor argues, as above indicated, that "there is no need to determine what disclosure might have been sufficient in 1953" until after appellants have established "that their present specification is sufficient." The complete answer, of course, is that one who can establish sufficiency of a 1971 disclosure *has no need* to establish sufficiency of a 1953 disclosure, and no need to exercise his right to the benefit of 35 USC 120.

Fully applicable to appellants' right under 35 USC 120 is this Supreme Court statement in *United States v. American Bell Telephone Co.*, 167 U.S. 224, 247 (1897):

A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are

questions not of natural but of purely statutory right.

[1] The board's error in disregarding the effect of 35 USC 120 is highlighted by the legislative and judicial background of the statutory provision, which extends over more than a century. The Reviser's Note states: "This section represents *present law* not expressed in the statute \* \* \*." (Emphasis added.) P.J. Federico's *Commentary on The New Patent Act*, 35 USCA p.1, at p.31 (1954), notes that the benefit provided by §120 "was not specified in the old statute but was developed by decisions of the courts beginning with a decision of the Supreme Court of 1864, *Godfrey v. Eames*, 68 U.S. 317." *Godfrey v. Eames* discusses the benefit accorded to the applicant in the following passage:

In our judgment, if a party choose to withdraw his application for a patent, and pay the forfeit, intending at the time of such withdrawal to file a new petition, and he accordingly do so, the two petitions are to be considered parts of the *same transaction*, and both *as constituting one continuous application*, within the meaning of the law. [Emphasis added.] [68 U.S. at 325-26.]<sup>11</sup>

The Supreme Court's explanation illuminates the meaning of "shall have the same effect" and clearly requires that we view appellants' applications as "parts of the same transaction" and "as constituting one continuous application" for the continuing subject matter recited therein.

[2] We held in *In re Glass*, 492 F.2d 1228, 1232, 181 USPQ 31, 34 (CCPA 1974), that an applicant could not rely on what occurred in the art after his filing date because "application sufficiency under §112, first paragraph, must be judged as of its filing date."<sup>12</sup> That principle applies equally to the PTO with respect to a continuing application entitled under §120 to the benefit of an earlier filing date. No rational distinction can be made in the treatment accorded to the subject matter of an original application and to the same subject matter disclosed in a continuing application. Courts should not treat the same legal question, enablement under §112, in one manner with respect to the applicant and in a

<sup>11</sup> A requirement for copendency is now set forth in 35 USC 120.

<sup>12</sup> Accord, *In re Gunn*, 537 F.2d 1123, 190 USPQ 402 (CCPA 1976); *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974).

different manner with respect to the examiner.

[3] The examiner and the board, in support of the §112 rejection, cited Natta, Haven, Edwards ('022), and Edwards ('500), not as *prior art*, but as *evidence* to prove appellants' disclosure non-enabling for "other species" of the claimed polymer, in an effort, as judicially required, to show why the scope of enablement was insufficient to support the claims. See, e.g., *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976); *In re Armbruster*, 512 F.2d 676, 185 USPQ 152 (CCPA 1975); *In re Dinh-Nguyen*, 492 F.2d 856, 181 USPQ 46 (CCPA 1974); *In re Marzocchi*, 58 CCPA 1069, 439 F.2d 220, 169 USPQ 367 (1971). As thus implicitly recognized, the references would not have been available in support of a 35 USC 102 or 103 rejection entered in connection with the 1953 application. To permit use of the same references in support of the 35 USC 112 rejection herein, however, is to render the "benefit" of 35 USC 120 illusory.<sup>13</sup> The very purpose of reliance on §120 is to reach back, to avoid the effect of intervening references. Nothing in §120 limits its application to any specific grounds for rejection, or permits the examiner, denied use of references to reject or to require narrowing of a claim under §102 or 103, to achieve the same result by use of the same references under §112. Just as justice and reason require application of §112 in the same manner to applicants and examiners, symmetry in the law, and evenness of its application, require that §120 be held applicable to all bases for rejection, that its words "same effect" be given their full meaning and intent.

[4] The clear and unambiguous language of §120 states that "[a]n application \* \* \* for an invention disclosed in the manner provided by the first paragraph of section 112 \* \* \* in an application previously filed in the United States \* \* \* shall have the same

effect, as to such invention, as though filed on the date of the prior application \* \* \*," (Emphasis added.) Thus, appellants' 1971 application should have been given "the same effect," i.e., it should have been tested for compliance with §112, first paragraph, "as though filed on the date of the prior application," to wit, 1953 with respect to claims 13 and 15<sup>14</sup> and 1956 with respect to claim 14.

[5] Because the board did not consider appellants' ancestral applications in affirming the rejections under §112, first paragraph, in view of the cited references, those rejections must be reversed and the case remanded to permit consideration of enablement questions as of the proper filing date.<sup>15</sup>

## II. Employment of a Later State of the Art in Testing For Compliance With 35 USC 112, First Paragraph

The pendency since 1953 of appellants' applications, giving rise to concern over whether a claim may issue of breadth sufficient to encompass the later existing, "non-enabled" amorphous polymers of Edwards, and the PTO's application to the present facts of this court's statement in *In re Moore*, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236 (1971) that "the scope of enablement" must be "commensurate with the scope of protection sought," impel clarification.

Citing *Moore*, the examiner stated that the §112 rejection "is premised on the fact that while the claims are generic in nature, applicants have, at best, only described a very limited species within the generic class." Further, the examiner said "[t]he disclosure \* \* \* is non-enabling on how to prepare other species of this [claimed] polymer such as those of [the four cited references] which, as far as this record is concerned, could not be prepared with the supported chromium oxide catalyst." The board, in adopting the examiner's reasoning, recognized that its primary basis was the Edwards polymer: "The claims on appeal, however, are not limited to a crystalline polymer \* \* \* but encompasses

<sup>13</sup> It would also exalt form over substance. If the present appellants had not filed continuing applications, the only filing date involved would be that of the 1953 application. To judge the 1971 application in isolation would have a chilling effect upon the right of applicants to file continuations. The 24 years of pendency herein may be decried, but a limit upon continuing applications is a matter of policy for the Congress, not for us. See *In re Henriksen*, 55 CCPA 1384, 1395, 399 F.2d 253, 262, 158 USPQ 224, 231 (1968). As presently constituted, the law as set forth in 35 USC 112 and 120 is the same for all applications, whether of long or short pendency.

<sup>14</sup> Appellants allege entitlement to the 1953 filing date for claim 15. As discussed *infra*, claim 15 is not entitled to either the 1953 or 1956 filing date.

<sup>15</sup> It is immaterial under 35 USC 120 that the subject matter of claim 13 was not specifically claimed in the 1953 application. *In re Brower*, 58 CCPA 724, 433 F.2d 813, 167 USPQ 684 (1970).

[sic] an amorphous polymer [of Edwards] as well which is manifestly outside the scope of the enabling teaching present in the case." Thus, amorphous polymers not having been, on this record, in existence in 1953, the examiner and the board focused on the later state of the art represented by the 1962 filing date of Edwards.<sup>16</sup>

[6] A later state of the art is that state coming into existence after the filing date of an application. This court has approved use of later publications as evidence of the state of art existing on the filing date of an application.<sup>17</sup> That approval does not extend, however, to the use of a later (1967, Edwards) publication disclosing a later (1962) existing state of the art in testing an earlier (1953) application for compliance with §112, first paragraph. The difference may be described as that between the permissible application of later knowledge about art-related facts existing on the filing date and the impermissible application of later knowledge about later art-related facts (here, amorphous polymers) which did not exist on the filing date. Thus, if appellants' 1953 application provided sufficient enablement, considering all available evidence (whenever that evidence became available) of the 1953 state of the art, i.e., of the condition of knowledge about all art-related facts existing in 1953, then the fact of that enablement was established for all time and a later change in the state of the art cannot change it.

<sup>16</sup> According to the examiner and the board, Natta and Haven disclosed the same species disclosed by appellants and were applied under 35 USC 102 as statutory bars.

<sup>17</sup> Where, for example, a later publication evidenced that, as of an application's filing date, undue experimentation would have been required, *In re Corneil*, 52 CCPA 1718, 1724, 347 F.2d 563, 568, 145 USPQ 702, 705 (1965), or that a parameter absent from the claims was or was not critical, *In re Rainer*, 49 CCPA 1243, 1246 n.3, 305 F.2d 505, 507 n.3, 134 USPQ 343, 345 n.3 (1962), or that a statement in the specification was inaccurate, *In re Marzocchi*, 58 CCPA 1069, 1073 n.4, 439 F.2d 220, 223 n.4, 169 USPQ 367, 370 n.4 (1971), or that the invention was inoperative or lacked utility, *In re Langer*, 503 F.2d 1380, 1391, 183 USPQ 288, 297 (CCPA 1974), or that a claim was indefinite, *In re Glass*, supra, 492 F.2d at 1232 n.6, 181 USPQ at 34 n.6, or that characteristics of prior art products were known, *In re Wilson*, 50 CCPA 773, 311 F.2d 266, 135 USPQ 442 (1962). Whatever may have been said enroute to decision in these cases, the fact situation in none of them established a precedent for permitting use of a later existing state of the art in determining enablement under 35 USC 112.

Rejections under §112, first paragraph, on the ground that the scope of enablement is not commensurate with the scope of the claims, orbit about the more fundamental question: To what scope of protection is this applicant's particular contribution to the art entitled?

[7] Though we do not reach the point on this appeal, we note appellants' argument that their invention is of "pioneer" status. The record reflects no citation of prior art disclosing a solid polymer of 4-methyl-1-pentene, which may suggest that appellants at least broke new ground in a broad sense. On remand, appellants may be found to have been in fact the first to conceive and reduce to practice "a solid polymer" as set forth in claim 13. As pioneers, if such they be, they would deserve broad claims to the broad concept. What were once referred to as "basic inventions" have led to "basic patents," which amounted to real incentives, not only to invention and its disclosure, but to its prompt, early disclosure. If later states of the art could be employed as a basis for rejection under 35 USC 112, the opportunity for obtaining a basic patent upon early disclosure of pioneer inventions would be abolished.

[8] The PTO has not challenged appellants' assertion that their 1953 application enabled those skilled in the art in 1953 to make and use "a solid polymer" as described in claim 13. Appellants disclosed, as the only then existing way to make such a polymer, a method of making the crystalline form. To now say that appellants should have disclosed in 1953 the amorphous form which on this record did not exist until 1962, would be to impose an impossible burden on inventors and thus on the patent system. There cannot, in an effective patent system, be such a burden placed on the right to broad claims. To restrict appellants to the crystalline form disclosed, under such circumstances, would be a poor way to stimulate invention, and particularly to encourage its early disclosure. To demand such restriction is merely to state a policy against broad protection for pioneer inventions, a policy both shortsighted and unsound from the standpoint of promoting progress in the useful arts, the constitutional purpose of the patent laws. See *In re Goffe*, 542 F.2d 564, 191 USPQ 429 (CCPA 1976).

[9] In *In re Fisher*, 57 CCPA 1099, 1108, 427 F.2d 833, 839, 166 USPQ 18, 24 (1970), this court set forth the basic considerations respecting enablement and the potential for domination of future developments, describ-



ing the effect of predictability factors upon those considerations. We adhere to what was there said concerning the high level of predictability in mechanical or electrical environments and the lower level of predictability expected in chemical reactions and physiological activity. With respect to the erroneous use of a later state of the art in determining enablement, however, we make no distinction between fields of invention.

[10] Consideration of a later existing state of the art in testing for compliance with §112, first paragraph, would not only preclude the grant of broad claims, but would wreak havoc in other ways as well. The use of a subsequently-existing improvement to show lack of enablement in an earlier-filed application on the basic invention would preclude issuance of a patent to the inventor of the thing improved, and in the case of issued patents, would invalidate all claims (even some "picture claims") therein. Patents are and should be granted to later inventors upon unobvious improvements. Indeed, encouragement of improvements on prior inventions is a major contribution of the patent system and the vast majority of patents are issued on improvements. It is quite another thing, however, to utilize the patenting or publication of later existing improvements to "reach back" and preclude or invalidate a patent on the underlying invention.

If applications were to be tested for enablement under §112 in the light of a later existing state of the art, the question would arise over how much later. An examiner could never safely call a halt and pass an application to issue. One who had slavishly copied the disclosed and claimed invention of a patent issued in 1965, for example, could resist an infringement action by insisting that a court hold the patent invalid because it was not enabling with respect to some third product which first came into existence, and thus came within the purview of the claim, in 1975.

[11] The PTO position, that claim 13 is of sufficient breadth to cover the later state of the art (amorphous polymers) shown in the "references," reflects a concern that allowance of claim 13 might lead to enforcement efforts against the later developers. Any such conjecture, if it exists, is both irrelevant and unwarranted. The business of the PTO is patentability, not infringement. Like the judicially-developed doctrine of equivalents, designed to protect the patentee with respect to later-developed variations of

the claimed invention,<sup>18</sup> the judicially-developed "reverse doctrine of equivalents," requiring interpretation of claims in light of the specification,<sup>19</sup> may be safely relied upon to preclude improper enforcement against later developers. The courts have consistently considered subsequently existing states of the art as raising questions of infringement, but never of validity. It is, of course, a major and infinitely important function of the PTO to insure that those skilled in the art are enabled, as of the filing date, to practice the invention claimed. If, in the light of all proper evidence, the invention claimed be clearly enabled as of that date, the inquiry under §112, first paragraph, is at an end.

### III. The Rejections of Claim 13 Under 35 USC 102

The filing date of appellants' 1953 application precedes Natta's publication date (December, 1955) by almost three years and it precedes Haven's effective date (June 23, 1955) as a prior art reference under 35 USC 102(e) by more than two years.

Therefore, if claim 13 is entitled to the benefit of the 1953 filing date, Natta and Haven are not prior art references against claim 13 and the rejections under §102 must fall. Because these rejections depend upon the same issue as that stated above for the §112 rejection of claim 13, they are also reversed and the case is remanded to the PTO for consideration of the correct issue.

### IV. The Rejections of Claim 14

#### A. The First Rejection Under 35 USC 112, First Paragraph

Claim 14 is not entitled to any date earlier than the 1956 filing date because, as appellants acknowledge, the disclosure to support claim 14 first appeared in the 1956 application. Each application since 1956 has contained the same basic disclosure with respect to claim 14.

What was said above, respecting the rejection of claim 13 under 35 USC 112, first paragraph, is equally applicable to this rejection of claim 14, except for substitution of the 1956 filing date for the 1953 filing date, and, as indicated, this rejection of claim 14 is reversed and the case is remanded to the PTO for consideration of the correct issue.

<sup>18</sup> See *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 85 USPQ 328 (1950).

<sup>19</sup> See *Westinghouse v. Boyden Power Brake Co.*, 170 U.S. 537, 568-69 (1898).

*B. The Second Rejection Under 35 USC 112, First Paragraph*

The second rejection of claim 14 under 35 USC 112, first paragraph, does not involve appellants' entitlement to an earlier filing date or the availability of any reference. It rests on the ground that the "disclosure does not teach how to prepare polymers having the claimed melting point range [390° to 425°F]."

Statement [C] teaches that appellants "have produced crystalline polymers of 4-methyl-1-pentene which have melting points in the range of 390 to 425°F." and statement [D] teaches that "4-methyl-1-pentene can be polymerized in substantially the same manner as previously described [to] produce crystalline polymers." (Emphasis added.) The "previously described" examples and technical information in the application give many details on how to make olefin polymers using a chromium oxide catalyst.

The examiner based this rejection on a prior board decision without explaining why the disclosure does not teach how to make the claimed invention.<sup>20</sup> The present board commented that statement [C] "stands alone," is "unconnected," and that it gives "no clue" on how to make the claimed polymer.

[12] The grounds advanced by the examiner and the board lack merit. Statement [C] does not "stand alone" and it is not "unconnected." Statement [C] must be read in light of the rest of the specification and it is clearly "connected," or related, to statement [D]. Statement [D] in turn is clearly connected to the detailed technical information on how to make olefin polymers. Neither the accuracy nor the sufficiency of that technical information has been questioned in this rejection. Thus, the examiner and the board effectively ignored statement [D] and the rest of the disclosure. This was error because the specification disclosure as a whole must be considered. In re Moore, supra.

The PTO not having carried its burden of establishing lack of enablement, this rejection of claim 14 under §112, first paragraph,

is reversed.

*C. The Rejection Under 35 USC 132*

Claim 14 was also rejected under 35 USC 132, because "the combination of 'homopolymer' and the melting point range of 390° to 425°F" was considered "new matter" added by amendment to the 1971 application.

[13] A new matter rejection under 35 USC 132, predicated on claim language, is tantamount to a rejection for lack of a written description of the claimed invention under 35 USC 112, first paragraph. In re Bowen, 492 F.2d 859, 864, 181 USPQ 48, 52 (CCPA 1974); In re Smythe, 480 F.2d 1376, 1385, 178 USPQ 279, 286 (CCPA 1973). This court has held that claimed subject matter need not be described in haec verba in the application to satisfy the written-description-of-the-invention requirement. In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973).

Statement [C] teaches that appellants "have produced crystalline polymers of 4-methyl-1-pentene which have melting points in the range of 390 to 425°F." One skilled in the art reading statement [C] would reasonably conclude that "polymers of 4-methyl-1-pentene" describes homopolymers (note 8, supra) of 4-methyl-1-pentene because that is the "necessary and only reasonable construction" to be given this statement. Vogel v. Jones, 486 F.2d 1068, 1075, 179 USPQ 425, 431 (CCPA 1973); Binstead v. Littmann, 44 CCPA 839, 844, 242 F.2d 766, 770, 113 USPQ 279, 282 (1957). If copolymers were being described, the sentence would refer to 4-methyl-1-pentene and some other monomer.

Accordingly, the rejection of claim 14 under 35 USC 132 is reversed.

*D. The Rejections Under 35 USC 102 and 103*

These prior art rejections of claim 14 depend upon the availability as prior art of Natta and Haven. Because the PTO did not test for compliance with the first paragraph of §112 as of the 1956 filing date, using the state of the art as of that date, the rejections of claim 14 under 35 USC 102 and 103 are reversed and we remand to the PTO so that the issue may be properly considered.

The filing date of appellants' 1956 application is subsequent to Natta's publication date (December, 1955) and to Haven's effective date (June 23, 1955). Therefore, if claim 14 is found on remand to be entitled to the benefit of the 1956 filing date, Natta and

<sup>20</sup> The examiner's answer did not base the rejection on the ground that claim 14 is limited to "a single 'species' of polymer which begins to melt at 390°F and is completely melted at 425°F." The examiner interpreted claim 14 as reciting this "species" or "any species that melt within its range."



Haven would be available as prior art and the PTO should consider the adequacy of appellants' affidavit under 37 CFR 1.131 (Rule 131).

Appellants have never contended that Natta's polymer was not the same as theirs. To the contrary, throughout the prosecution history and before this court, appellants have maintained that Natta's polymer and their polymer are substantially identical. Therefore, if on remand claim 14 is found not to be entitled to the benefit of the 1956 filing date, Natta is a statutory bar to claim 14. In re Foster, 52 CCPA 1808, 343 F.2d 980, 145 USPQ 166 (1965), cert. denied, 383 U.S. 966, 149 USPQ 906 (1966).

#### V. The Rejections of Claim 15

Claim 15 presents a situation different from that of claims 13 and 14 because, as appellants acknowledge, the disclosure to support claim 15 appears in the 1953 and the 1967 applications, but not in the 1956 application. Specifically, statement [B] and the Figure 2 graph showing the thermal depolymerization curves (Figure 5 in the 1971 application and referred to in claim 15) are not found in the 1956 application.

[14] Thus, with respect to the subject matter of claim 15, there is a clear gap in the continuity of disclosure necessary to secure the benefit of §120. As we stated in In re Schneider, 481 F.2d 1350, 1356, 179 USPQ 46, 50 (CCPA 1973):

[T]here has to be a continuous chain of copending applications each of which satisfies the requirements of §112 with respect to the subject matter presently claimed. See In re deSeversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). There must be continuing disclosure through the chain of applications, without hiatus, to ultimately secure the benefit of the earliest filing date.

Accord, In re Goodman, 476 F.2d 1365, 177 USPQ 574 (CCPA 1973).

Therefore, under §120, claim 15 is entitled only to the benefit of the 1967 filing date,<sup>21</sup> and Natta is a statutory bar with respect to claim 15. In re Foster, supra. The rejection of claim 15 under 35 USC 102, as anticipated by Natta, is therefore affirmed, and the rejections of claim 15 under 35 USC

112, first paragraph, and under 35 USC 102 as fully met by Haven, are moot.

#### Summary

(1) The rejections of claims 13 and 14 are reversed.

(2) The rejection of claim 15 under 35 USC 102 on Natta is affirmed. The remaining rejections of claim 15 are moot.

(3) The case is remanded for consideration of whether appellants' 1953 application was enabling with respect to claim 13 in view of the state of the art existing in 1953; whether appellants' 1956 application was enabling with respect to claim 14 in view of the state of the art existing in 1956, and, if so, whether appellants' affidavit under 37 CFR 1.131 was adequate to overcome Natta and Haven as references.

Modified and remanded.

Miller, Judge, concurring in part.

I join the majority with respect to claim 15. However, I can only concur in the result reached by the majority with respect to claims 13 and 14.

The majority opinion properly holds that the board erred in considering the *later state of the art* in testing for compliance with the enablement requirement of 35 USC 112, paragraph 1. However, in discussing this issue, it states:

The pendency since 1953 of appellants' applications, giving rise to concern over whether a claim may issue of breadth sufficient to encompass the later existing, "non-enabled" amorphous polymers of Edwards, \* \* \* impel[s] clarification.

It then "clarifies" the matter by stating:

The PTO has not challenged appellants' assertion that their 1953 application enabled those skilled in the art in 1953 to make and use "a solid polymer" as described in claim 13. Appellants disclosed, as the only then existing way to make such a polymer, a method of making the crystalline form. \* \* \* To restrict appellants to the crystalline form disclosed, under such circumstances, would be a poor way to stimulate invention. \* \* \* To demand such restriction is merely to state a policy against broad protection for pioneer inventions. \* \* \*

Absent evidence to the contrary, the language in a patent application is to be in-

<sup>21</sup> We refrain from comment on appellants' hypothetical argument that the 1956 application could be amended to add the material in the 1953 application.

interpreted as it would have been at the time the application was filed. Although the PTO may rely on later art, it must show that the language used in that art would have meant the same to one skilled in the art at the time the patent application was filed. As this court stated in *In re Voss*, 542 F.2d 833, 838, 166 USPQ 18, 23 (1970), set forth in [footnote 6 of *In re Glass*, 492 F.2d 1228, 1232, 181 USPQ 31, 34 (CCPA 1974)], that the PTO can rely on such later-issued patents and publications only if a showing is made that such claim language is the "language of the present art" as of the filing date of the application in question:

[I]t is clear from the quotation from *In re Fisher*, 57 CCPA 1099, 1106, 427 F.2d 833, 838, 166 USPQ 18, 23 (1970), set forth in [footnote 6 of *In re Glass*, 492 F.2d 1228, 1232, 181 USPQ 31, 34 (CCPA 1974)], that the PTO can rely on such later-issued patents and publications only if a showing is made that such claim language is the "language of the present art" as of the filing date of the application in question.

The majority opinion, in extended dicta, relies on *In re Goffe*, 542 F.2d 564, 191 USPQ 429 (CCPA 1976), for the proposition that restricting the claims to the crystalline form, preventing broad protection for a "pioneer" invention, would be "a policy both shortsighted and unsound from the standpoint of promoting progress in the useful arts. \* \* \*". However, the facts before us are clearly different from those in *Goffe*. There, the claim language, well defined in the prior art, clearly delineated the "outer boundaries" of the claimed subject matter, and the question was whether there was enablement for every embodiment within the scope of the claims. Here, the question is: *in light of the interpretation of the claim language at the time the patent application was filed*, what are the "outer boundaries" of the claims? Thus, *Goffe* is inapposite.

Contrary to the majority opinion, to permit the "outer boundaries" of a claim to be construed in light of later art, rather than in light of art at the time the patent application was filed, could well *impede* progress in the useful arts. For example, it would relegate a later species invention (e.g., the solid amorphous homopolymer of Edwards) to a subservient position vis-a-vis an earlier species invention (e.g., the solid crystalline homopolymer disclosed by appellants), even though the earlier inventor did not contemplate, much less enable, a generic invention, merely because the patent application for the earlier invention used a *broad* term which, at the time, had a meaning to one skilled in the art that was coextensive with the species.

The majority opinion notes that the PTO's arguments evidence a concern that

allowance of claim 13 might lead to enforcement efforts against later developers, but states that any conjecture on this point is "both irrelevant and unwarranted," since "[t]he business of the PTO is patentability, not infringement," and "the judicially-developed 'reverse doctrine of equivalents,' requiring interpretation of claims in light of the specification, may be safely relied upon to preclude *improper* enforcement against later developers." (Emphasis in original. Footnote omitted.) Two comments seem appropriate. First, in saying that "[t]o restrict appellants to the crystalline form disclosed, under such circumstances, would be a poor way to stimulate invention," the majority opinion advocates a double standard: for the inventor, interpret the language of the claims against later developers in light of the later state of the art; but for the PTO, as *held* here, interpret such language against the inventor only in light of the state of the art at the time the application was filed. I do not agree that such a double standard is needed to spur invention. Second, the PTO, in managing its business of *patentability*, has a duty to construe the scope of the claims, to interpret the claim language in light of the specification and the art existing at the time the patent application was filed, and to determine whether the scope of enablement is commensurate with the scope of the claims. If, on remand, the PTO should determine that, at the time appellants' application was filed, one skilled in the art would have interpreted the phrase "solid homopolymer" broadly to include both crystalline and amorphous homopolymers, the PTO could, nevertheless, find that appellants' disclosure was only enabling to make a crystalline homopolymer and could properly reject claims 13 and 14 under the first paragraph of 35 USC 112 as of broader scope than the scope of enablement. On the other hand, if the PTO should determine that, at the time appellants' application was filed, one skilled in the art would have interpreted the phrase "solid homopolymer" to include only a crystalline homopolymer, a finding of enablement, at the time appellants' application was filed, to make a crystalline homopolymer would end the inquiry under §112, first paragraph.

of an offending trademark use will have imputed to it the knowledge of that employee. *Dawn Donut v. Hart's Food Stores*, 267 F.2d 358, 363, 121 USPQ 430, 434 (2d Cir. 1959).

Other evidence tending to show Georgia-Pacific's "corporate" awareness of Great Plains' use of the mark include Stearley's testimony<sup>1</sup> that Great Plains sold a significant number of multi-wall bags to Georgia-Pacific and that virtually all multi-wall bags produced by Great Plains had a logo imprinted thereon. In total, over thirty transactions (including nine sales of paper) took place between 1962 and 1969.

The totality of the evidence points to the existence of constructive knowledge by Georgia-Pacific of Great Plains' use of the mark.

[8] It is well settled that one who charges estoppel by laches must also show that it suffered or will suffer detriment as a result of inaction by the party against which laches is charged. *United States v. Alex Dussel Iron Works*, 31 F.2d 535 (5th Cir. 1929). Great Plains has shown that sales of its goods under the logo in question have grown from \$372,000 in 1961 to about \$28,000,000 in 1973. It is this extent of sales over a protracted length of time without complaint from Georgia-Pacific upon which Great Plains relied to its detriment. Any change in trademark status at this point would be to the prejudice of Great Plains.

#### Conclusion

In sum, we hold the likelihood of confusion between the marks as applied to their respective goods unlikely and further hold that Georgia-Pacific is estopped from asserting such likelihood. Therefore, we *affirm* the decision of the board.

*Affirmed.*

<sup>1</sup> Mr. Stearley, on the occasion of the deposition, was President and General Manager of Great Plains Bag Corporation and had been with that company in various capacities since 1963.

## Court of Customs and Patent Appeals

In re Koller, Hartl, and Kirchner

No. 79-589

Decided Jan. 24, 1980

### PATENTS

#### 1. Construction of specification and claims — Broad or narrow — In general (§22.101)

#### Construction of specification and claims — By specification and drawings — In general (§22.251)

#### Specification — Sufficiency of disclosure (§62.7)

It does not follow from fact that disclosure of specifics adds to understanding one skilled in art would glean from generic term that such added disclosure limits its meaning; indeed, neither listing of representative compounds nor example is always necessary in completely describing generic class; presence of specific examples in specification that provides statutory description via generic expression that is understandable cannot, in ex parte practice, limit that expression; claims are given broadest reasonable interpretation, consistent with specification, during prosecution of application; however, claims in issued patent may sometimes be interpreted by court in light of specification so as to protect only that phase of claimed invention that constitutes patentable subject matter and thus do justice and equity between parties.

#### 2. Applications for patent — Continuing (§15.3)

#### Specification — Claims as disclosure (§62.3)

#### Specification — Sufficiency of disclosure (§62.7)

Compliance with Section 112, paragraph one, is judged as of date application is filed; original claims constitute their own description; later added claims of similar scope and wording are described thereby.

#### 3. Construction of specification and claims — By prior art (§22.20)

#### Patentability — Evidence of — State of art (§51.467)

#### Specification — Sufficiency of disclosure (§62.7)

Later-issued patents and publications may, under certain narrow circumstances, be used to show state of art existing on date

of application in question; these circumstances, are, for example, where later publication evidenced that as of application's filing date undue experimentation would have been required, parameter absent from claims was or was not critical, statement in specification was inaccurate, invention was inoperative or lacked utility, characteristics of prior art products were known, or claim was indefinite; however, use of later existing state of art is not permitted in determining enablement under 35 U.S.C. 112; Patent Office can rely on later-issued patents and publications to construe claim language only if showing is made that that claim language is "language of the present art" as of filing date of application in question.

#### 4. Patentability — Anticipation — In general (§51.201)

##### Patentability — Anticipation — Carrying date back of references (§51.203)

Decision of Board of Appeals affirming rejection under Section 102 is reversed where application's filing date is prior to effective date of any of cited references.

##### Particular patents — Isohumulone

Koller, Hartl, and Kirchner, Method of Isomerizing Humulone to Isohumulone by Catalytic Acceleration with Metal Salts, rejection of claims 1-3 and 5-14 reversed.

Appeal from Patent and Trademark Office Board of Appeals.

Application for patent of Horst Koller, Allons E. Hartl, and Gerhard Kirchner, Serial No. 582,774, filed June 2, 1975. From decision rejecting claims 1-3 and 5-14, applicants appeal. Reversed.

Roger L. Browdy, Washington, D.C., for appellants.

Joseph F. Nakamura (Harry I. Moatz, of counsel) for Commissioner of Patents and Trademarks.

Before Markey, Chief Judge, Rich, Baldwin, and Miller, Associate Judges, and Newman, Judge.\*

Baldwin, Judge.

This is an appeal from the decision of the United States Patent and Trademark Office (PTO) Board of Appeals (board) affirming

the rejection of claims 1-3 and 5-14 in appellants' application serial No. 582,774, filed June 2, 1975, entitled "Method of Isomerizing Humulone to Isohumulone by Catalytic Acceleration with Metal Salts."<sup>1</sup> The claims are rejected as anticipated under 35 USC 102. We reverse.

#### The Invention

Appellants claim a method for producing isohumulone from humulone. Isohumulone is a chemical said to be useful as a tuberculosis retardant. It is also the essential part of "hops-bitters" used in the brewing of beer.

The claimed invention involves the steps of forming a liquid mixture of the reactant humulone, a sufficient amount of certain metal salts (the cation of which is a member of Group IIa or IIb, or the Iron group of the periodic table, or cerium and manganese) said to be catalytic or complex-forming, and a "liquid medium." The desired isomerization takes place at an "elevated temperature," desirably at the boiling point of the system, and at a pH preferably between 4 and 9.

Claims 1 and 13 are illustrative of the invention:

1. A method for preparing isohumulone products, comprising:

providing a mixture of (1) a salt productive in an aqueous medium of an anion and a cation, said anion being inert to the starting material and inert to the isohumulone products under the operating conditions of the present method, and said cation being an element selected from the group consisting of Group IIa or IIb elements, Fe group elements, cerium and manganese, (2) humulone or a humulone-containing material, and (3) a liquid medium, inert to the starting materials and to the isohumulone produced under the operating conditions of the present method, said liquid medium being one in which said salt dissociates to form said anion and said cation and said humulone or humulone-containing material dissociates to form humulate anion; and isomerizing at an elevated temperature, at a pH below 9 and greater than that pH.

<sup>1</sup> This case is a continuation of application serial No. 356,785, filed May 3, 1973, (now U.S. Patent No. 3,952,061, hereinafter "the parent") which in turn is a continuation-in-part of serial No. 725,458, filed April 30, 1968, now abandoned (hereinafter "the grandparent").

\* The Honorable Bernard Newman, United States Customs Court, sitting by designation.

at which humulone forms humulate anion in solution;

wherein said salt is present in an amount sufficient to accelerate said isomerization.

13. A method of preparing isohumulone products, comprising:

combining (1) humulone or humulone-containing material, (2) a liquid medium inert to the reaction materials, in which both humulone and the salt to be used are soluble, and (3) a salt productive in said liquid medium of an elemental cation of an element selected from the group consisting of Group IIa or IIb elements, Fe group elements, cerium and manganese in an amount sufficient to accelerate isomerization; and

isomerizing at an elevated [sic] temperature, at a pH lower than about 9 and above 4.

#### *The Rejection*

The examiner rejected all of the claims under 35 USC 102 as unpatentable in view of Worden, U.S. Patent No. 3,923,897, filed April 2, 1973. Worden discloses a similar process but in the main was utilized for its disclosure of Todd (Belgian patent No. 782,900 or U.S. Patent No. 4,002,683). Todd is admitted by all parties to be anticipatory of the claims (if the grandparent lacks §112 description) especially in view of its discussion of the British equivalent to the grandparent application of this case.

#### *Background*

The ultimate issue in this case is whether or not the grandparent application provides a written description of the claimed invention in the manner required by 35 USC 112. If it does, the decision of the board with regard to §102 is improper since the filing date of the grandparent is prior to the effective date of any of the cited references.

The bone of contention between the parties here is the meaning to be assigned the term "liquid medium." The basic argument stated by the PTO is that the term varies in breadth from the grandparent to this case. The appellant maintains that the term is a broad term throughout.

The examiner, in his Answer, specifically discussed the term and his view of the etymology of the term:

The grandparent application discussed the process throughout the disclosure referring to "liquid medium", "solvent", "dispersing agent", etc. However, the specific disclosure with respect to the solvent system used discloses, "As a reaction medium one can in principle use water to

which, however, a water-miscible organic solvent is added as solubilizer, since humulon is practically insoluble in water. As mentioned above, water-ethanol mixtures are preferred." None of the examples in the grandparent application use other than aqueous systems consisting of water or water in addition to a water-miscible solvent such as ethanol. It is only with the filing of the continuation-in-part application, the parent of this application, now U.S. Patent No. 3,952,061, that appellants added examples drawn to the use of water-immiscible solvent systems. Appellants recognized the fact that there was no support in the original application to claim the use of a water-immiscible system which they are now trying to recoup in view of the Worden patent disclosure. It is interesting to note that in the parent application, appellants cancelled all claims directed to the use of water-immiscible solvent systems in view of a rejection over their [sic] own priority documents which had become available as prior art, \* \* \* Up until Worden published his invention, no one had ever isomerized the alpha-acids of hops resins to iso-alpha acids in non-aqueous systems. It was Worden that [sic] discovered the great processing benefits that accrued to the use of such a system. The use of aqueous systems in place of non-aqueous systems prior to Worden was unknown. Therefore, appellants cannot allege that the use of non-aqueous systems was implied in their original disclosure since it was not specifically used, disclosed or known in the art at that time. Appellants readily admit that they added new matter in the continuation-in-part application but are attempting to imply that it was there all the time. If it were present in the parent (grandparent of this application), the new matter would not have been needed nor the additional added examples. Appellants [sic] position is believed to be in error since (1) there is no specific disclosure of the use of non-aqueous systems, the contrary being true, and (2) it cannot be inferred that the use of non-aqueous systems would have [been] readily apparent to one skilled in the art prior to Worden since the use of non-aqueous systems was the invention of Worden and not known in the art at that time.

The board affirmed the rejection and in doing so stated:

The Examiner holds that the grandparent application does not contain a description of water-immiscible solvents

as the liquid medium in which the isomerization is effected.

The appellants argue that the term "liquid medium" set forth in the grandparent application broadly covers all solvents in which the isomerization is effected and hence encompasses the water-immiscible solvents shown by Worden.

We have carefully considered all of the arguments but we are not convinced of reversible error in the Examiner's rejection. The instant application is not entitled to the benefit of the filing date of the grandparent application since it fails to satisfy the description requirements of 35 USC 112 with respect to the disclosure of water-immiscible solvents. Although the grandparent application employs the term "liquid medium" for the isomerization of humulone, we do not find that it clearly and unequivocally describes the use of water-immiscible solvents. We find no delineation nor express description of any water-immiscible solvent either generally or specifically to serve as support for the present claims which encompass such solvent.

The use of aqueous or aqueous-alkanol media at 50°C or above, as disclosed in the earlier application, does not serve as basis for liquid medium such as methylene chloride indicated by Todd (cited by appellants) as suitable at ambient temperature. We find nothing in the grandparent to suggest the use of water-immiscible solvents or that isomerization can be effected below 50°C. The concept of isomerization taking place in the organic water-immiscible phase is nowhere suggested, taught or described by appellants prior to the filing of their parent application on May 30, 1973. Nor, as pointed out by the Examiner, would it have been obvious to employ such solvents at that time.

Considering the disclosure as a whole, one of ordinary skill in the art at the time of the filing of the grandparent application, would have been taught how to isomerize humulone by addition of polyvalent metal salts in aqueous or aqueous alkanolic media. The broad recitation "liquid medium" would have been construed by one skilled in the art from the disclosure, as consisting of water or water to which a miscible organic solvent is added. The term as now interpreted by appellants is broader than that disclosed in the grandparent application.

The subsequent discovery by Todd, referred to in Worden, of employing

water-immiscible solvents for the isomerization step merely confirms the unpredictable and unobvious nature of the liquid medium and as such, requires a clearer disclosure thereof than that which appellants provide in the grandparent. The finding by Todd, for which a patent was obtained, that water-immiscible solvents could be used for isomerization below 50°C cannot nunc pro tunc be considered as part of appellants' invention as of the time of the grandparent application which is completely devoid of any concept of effecting the isomerization at low temperature, that is, below 50°C.

We do not find the issue here to be a question of enablement but to be more properly one of description in the grandparent application. The fact that the recitation "liquid medium" might include water-immiscible solvents is not sufficient indication to one of ordinary skill at that time that such medium was part of appellants' invention. *In re Winkhaus et al.*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975). On the contrary, a fair reading of the grandparent disclosure would have led one to conclude that the isomerization in water and water-miscible media was appellants' contribution. Accordingly, it is our view that appellants are not entitled to the benefit of their grandparent application and the rejection of the claims under 35 USC 102 over Worden is sustained.

### Opinion

[1] The solicitor argues that the recitation of the broad term "liquid medium" in the body and claims of the grandparent specification is merely "fortuitous" and must be understood to mean only the narrower term "water-miscible solvent." The reasoning supplied by the PTO is that disclosed narrow classes, examples and enumerated compounds must be considered in fleshing out; giving meaning to, and therefore limiting a generic expression. Certainly, the disclosure of specifics *adds* to the understanding one skilled in the art would glean from a generic term, but it does not follow that such added disclosure *limits* the meaning thereof. See *In re Fuetterer*, 50

<sup>2</sup> It is apparent that appellants specifically placed the broad phrase in the grandparent specification and supplemented it by a narrower phrase and certain examples. Why the deliberate act of the inventors in placing two phrases of varying scope in the document is "fortuitous" is manifestly unclear.



CCPA 1453, 319 F.2d 259, 138 USPQ 217 (1963). Indeed, neither a listing of representative compounds nor an example is always necessary in completely describing a generic class. See *In re Robins*, 57 CCPA 1321, 429 F.2d 452, 166 USPQ 552 (1970). If a specification provides a statutory description via a generic expression which is understandable, the presence of specific examples cannot, in *ex parte* practice,<sup>1</sup> be said to limit that expression.

[2] Compliance with §112, paragraph one, is to be judged as of the date the application is filed. *In re Hogan*, 559 F.2d 595, 194 USPQ 527 (CCPA 1977); *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974). A comparison of the claims in this case, *supra*, with the original claims in the grandparent<sup>2</sup> reveals not only that the term "liquid medium" is found in both places, but also that the two sets of claims are similar in wording. *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA 1973), this court noted that original claims constitute their own description. Later added claims of similar scope and wording are described thereby.

Nevertheless, the PTO argues that Todd is evidence that, as of the filing date of the grandparent, one having ordinary skill in the art would not have recognized the inclusion of water-immiscible solvents within the scope of the term "liquid medium." Todd does disclose, at a subsequent time, that water-immiscible solvents are useful in the process.

[3] We recognize that, under certain narrow circumstances, later-issued patents

<sup>1</sup> Claims are given the broadest reasonable interpretation, consistent with the specification, during prosecution of an application. However, claims in an issued patent may sometimes be interpreted by a court "in light of the specification" so as "to protect only that phase of the claimed invention that constitutes patentable subject matter and thus do justice and equity between the parties." *In re Prater*, 56 CCPA 1381, 1395, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (1969).

<sup>2</sup> The grandparent's original claims 1 and 2 provide:

1. A method of preparing isohumulon by isomerization of humulon or humulon-containing material at elevated temperatures in a liquid medium, characterized by the fact that the isomerization catalyzes by addition of at least one salt of a bivalent metal or of cerium.

2. A method according to claim 1, characterized by the fact that as catalyst there are used salts of elements of groups IIA or IIB of the periodic system of the elements, of the iron group of the periodic system of elements, or of cerium or manganese.

and publications may be used to show the state of the art existing on the date of the application in question.<sup>3</sup> However, the circumstances here do not fit any exception to the general rule that language in a specification is to be understood for what it meant to one having ordinary skill in the art at the time the application was filed. *In re Glass*, *supra*; *In re Argoudelis*, 58 CCPA 769, 434 F.2d 1390, 168 USPQ 99 (1970). Todd's discussion of the invention found in the grandparent was based on his reading of the "British Patent Specification published 16 July 1969." Consequently, whatever Todd may have said concerning the meaning of the phrase "liquid medium" must be understood to have occurred at some time after July 1969 — a time clearly subsequent to the filing date of the grandparent in April of 1968.

<sup>3</sup> These circumstances were listed in *In re Hogan*, *supra* at 605 n.17, 194 USPQ at 537 n.17:

Where, for example, a later publication evidenced that, as of an application's filing date, undue experimentation would have been required. *In re Corneil*, 52 CCPA 1718, 1724, 347 F.2d 563, 568, 145 USPQ 702, 705 (1965), or that a parameter absent from the claims was or was not critical. *In re Rainer*, 49 CCPA 1243, 1246 n.3, 305 F.2d 505, 507 n.3, 134 USPQ 343, 345 n.3 (1962), or that a statement in the specification was inaccurate. *In re Marzocchi*, 58 CCPA 1069, 1073 n.4, 439 F.2d 220, 223 n.4, 169 USPQ 367, 370 n.4 (1971), or that the invention was inoperative or lacked utility. *In re Langer*, 503 F.2d 1380, 1391, 183 USPQ 288, 297 (CCPA 1974), or that a claim was indefinite. *In re Glass*, *supra*, 492 F.2d at 1232 n.6, 181 USPQ at 34 n.6, or that characteristics of prior art products were known. *In re Wilson*, 50 CCPA 773, 311 F.2d 266, 135 USPQ 442 (1962). Whatever may have been said enroute to decision in these cases, the fact situation in none of them established a precedent for permitting use of a later existing state of the art in determining enablement under 35 USC 112. [Emphasis in original.]

One additional comment was made in *In re Voss*, 557 F.2d 812, 818 n.15, 194 USPQ 267, 272 n.15 (CCPA 1977):

We note the dictum in footnote 6 of *Glass* \* \* \* [*In re Glass*, 492 F.2d 1228, 1232, 181 USPQ 31, 34 (CCPA 1974)] indicating that later-issued patents or publications may be used to construe claim language. However, it is clear from the quotation from *In re Fisher*, 57 CCPA 1099, 1106, 427 F.2d 833, 838, 166 USPQ 18, 23 (1970), set forth in the footnote that the PTO can rely on such later-issued patents and publications only if a showing is made that such claim language is the "language of the present art" as of the filing date of the application in question. The PTO has made no such showing in this case.

This case parallels *In re Hogan*, supra. Hogan filed an application in 1953 (to which the application there in issue was related under 35 USC 120) disclosing a solid polymer produced from 4-methyl-1-pentene. The only method disclosed entailed the production of a *crystalline* polymer. During 1962 another applicant disclosed that an *amorphous* form of the polymer could be produced. The PTO challenged the scope of enablement in that 1953 specification in asserting, based on the subsequent 1962 disclosure, that the generic disclosure did not encompass amorphous polymers but only crystalline ones.

We remanded that case and stated:

Though we do not reach the point on this appeal, we note appellants' argument that their invention is of "pioneer" status. The record reflects no citation of prior art disclosing a solid polymer of 4-methyl-1-pentene, which may suggest that appellants at least broke new ground in a broad sense. \* \* \* As pioneers, if such they be, they would deserve broad claims to the broad concept. What were once referred to as "basic inventions" have led to "basic patents," which amounted to real incentives, not only to invention and its disclosure, but to its prompt, early disclosure. If later states of the art could be employed as a basis for rejection under 35 USC 112, the opportunity for obtaining a basic patent upon early disclosure of pioneer inventions would be abolished. [Supra at 606, 194 USPQ at 537.]

In *Hogan*, an analysis using later-filed references to determine the scope of enablement was found to be impermissible. Similarly, it cannot be allowed when, as here, the description requirement is in issue.

[4] In sum, the phrase "liquid medium" in the present claims is described in the grandparent case in the manner required by 35 USC 112, paragraph one. Consequently, the decision of the board of appeals affirming the rejection under §102 is reversed.

*Reversed.*

District Court, N.D. Alabama,  
W. Div.

Pizitz, Inc.

v. Pizitz Mercantile Co. of Tuscaloosa,  
Inc. et al.

No. 77-G-1582-W

Decided Mar. 30, 1979

## TRADEMARKS

### 1. In general (§67.01)

Acquisition of marks — Character and extent of use — Dealer versus principal (§67.077)

### Fraud and misrepresentation (§67.37)

Name under which party markets its goods would constitute trademark; private clothing labels are protected trademarks despite outside manufacture of garments to which they are affixed.

## UNFAIR COMPETITION

### 2. Jurisdiction of courts — Joinder of causes of action and parties — Trademarks and unfair competition (§43.357)

28 U.S.C. 1338(b) provides federal district court with original jurisdiction of any civil action asserting claim of unfair competition when joined with substantial and related claim under trademark laws; test for "related claim" refers to probative facts; both trademark and unfair competition questions must rest on substantial identity of facts, but they need not be exactly the same.

## TRADEMARKS

### 3. Jurisdiction of courts — Declaratory judgment — In general (§43.301)

Plaintiff may seek declaration of non-infringement, since it is not required to act at its peril until defendant would commence action charging it with infringement.

## TRADEMARKS

### 4. Jurisdiction of courts — Declaratory judgment — In general (§43.301)

Federal district court has authority under 28 U.S.C. 2202, which has clear purpose of allowing litigants opportunity to achieve complete relief without engaging in multiple litigation, to proceed to fashion relief so as to minimize confusion between parties.

## UNFAIR COMPETITION

### 5. Names — Secondary meaning (§68.725)

Doctrine of secondary meaning, to preclude use of name, is generally attached to finding of bad faith.